

JC688 U.S. PTO  
01/17/00

Please type a plus sign (+) inside this box →

PTO/SB/21 (6-98)  
Approved for use through 09/30/2000, OMB 0651-0031  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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JC688 U.S. PTO  
09/483837  
01/17/00

# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

Total Number of Pages in This Submission	Attorney Docket Number
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70025-9902-11

**ENCLOSURES (check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached  <input checked="" type="checkbox"/> Preliminary Amendment / Response <input type="checkbox"/> After Final <input checked="" type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input checked="" type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input checked="" type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Additional Enclosure(s) (please identify below): <div style="border: 1px solid black; width: 100%; height: 40px; margin-top: 5px;"></div>
<b>Remarks</b> New Application Transmittal, Original Specification, Claims, Abstract, and Drawings; Original Declaration and small entity verification; supplemental declaration		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Stephen A. Slusher PEACOCK, MYERS & ADAMS, P.C.
Signature	
Date	

**CERTIFICATE OF MAILING** Exp. Mail No. EL393280048US

I hereby certify that this correspondence is being deposited with the United States Postal Service as ~~Priority Mail~~ mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date:

Typed or printed name	Michael C. Houck, Paralegal
Signature	
Date	January 17, 2000

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/17 (6/99)

Approved for use through 09/30/2000. OMB 0651-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# FEE TRANSMITTAL

## for FY 1999

*Patent fees are subject to annual revision.*

*Small Entity payments must be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12. See 37 C.F.R. §§ 1.27 and 1.28.*

TOTAL AMOUNT OF PAYMENT (\$ 573.00)

Complete if Known

Application Number	500000000000
Filing Date	January 17, 2000
First Named Inventor	Shubh D. Sharma
Examiner Name	D. Jones
Group / Art Unit	1616
Attorney Docket No.	70025-9902-11

METHOD OF PAYMENT (check one)				FEE CALCULATION (continued)				
1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any over payments to: Deposit Account Number 13-4213  Deposit Account Name Peacock, Myers & Adams  <input type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17				<b>3. ADDITIONAL FEES</b> Large Entity Small Entity Fee Fee Fee Fee Fee Description Code (\$) Code (\$) Code (\$) Code (\$) Fee Paid				
				105	130	205	65	Surcharge - late filing fee or oath
				127	50	227	25	Surcharge - late provisional filing fee or cover sheet.
				139	130	139	130	Non-English specification
				147	2,520	147	2,520	For filing a request for reexamination
				112	920*	112	920*	Requesting publication of SIR prior to Examiner action
				113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action
				115	110	215	55	Extension for reply within first month
				116	380	216	190	Extension for reply within second month
				117	870	217	435	Extension for reply within third month
				118	1,360	218	680	Extension for reply within fourth month
				128	1,850	228	925	Extension for reply within fifth month
				119	300	219	150	Notice of Appeal
				120	300	220	150	Filing a brief in support of an appeal
				121	260	221	130	Request for oral hearing
				138	1,510	138	1,510	Petition to institute a public use proceeding
				140	110	240	55	Petition to revive - unavoidable
				141	1,210	241	605	Petition to revive - unintentional
				142	1,210	242	605	Utility issue fee (or reissue)
				143	430	243	215	Design issue fee
				144	580	244	290	Plant issue fee
				122	130	122	130	Petitions to the Commissioner
				123	50	123	50	Petitions related to provisional applications
				126	240	126	240	Submission of Information Disclosure Stmt
				581	40	581	40	Recording each patent assignment per property (times number of properties)
				146	760	246	380	Filing a submission after final rejection (37 CFR § 1.129(a))
				149	760	249	380	For each additional invention to be examined (37 CFR § 1.129(b))
				Other fee (specify) _____				
				Other fee (specify) _____				
				SUBTOTAL (3) (\$)				
				Reduced by Basic Filing Fee Paid				

## SUBMITTED BY

Complete if applicable

Name (Print/Type)	Stephen A. Slusher	Registration No. (Attorney/Agent)	43,924	Telephone	(505) 998-6130	
Signature					Date	January 17, 2000

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Preliminary classification:  
Proposed Class: 424.001.690  
Subclass:

*NOTE: All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferable class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example >Proposed Class 2, subclass 129, M.P.E.P. § 601, 7<sup>th</sup> ed.*

Box Patent Application  
Assistant Comm. for Patents  
Washington, D.C. 20231

jc688 U.S. PTO  
09/483837  
01/17/00



Practitioner Docket No. 70025-9902-11

### NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of  
Inventor(s):

SHUBH D. SHARMA

**WARNING:**      37 CFR 1.41(a) (1) points out:  
                      "(a) A patent is applied for in the name or names of the actual inventor or inventors.

*"(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b) unless a petition under this paragraph accompanied by the fee set forth in § 1.17(l) is filed supplying or changing the name or names of the inventor or inventors."*

For (title):

METALLOPEPTIDE AND METALLO-CONSTRUCTS COMBINATORIAL  
LIBRARIES AND APPLICATIONS

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CERTIFICATION UNDER 37 CFR 1.10\*  
(Express Mail label number is mandatory.)  
(Express Mail certification is optional.)

I hereby certify that this New Application Transmittal and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date, January 17, 2000 in an envelope as "Express Mail Post Office to Addressee" Mailing Label No. EL393280048US addressed to the: Box: PATENT APPLICATIONS, Assistant Commissioner for Patents, Washington, D.C. 20231.

Michael C. Houck, Paralegal

(Signature of person mailing paper)

NOTE: Certificate of mailing (first class) or facsimile transmission procedures of 37 CFR 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

**NOTE:** Each paper or fee referred to as enclosed herein must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 CFR 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail Mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition," Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439 at 56,442.

## 1. Type of Application

This new application is for a(n) (check one applicable item below):

Original (Nonprovisional)  
 Design  
 Plant

**WARNING:** Do not use this transmittal for a completion in the U.S. of an International Application under 35 U.S.C. 371(c)(4) unless the international Application is being filed as a divisional, continuation or continuation-in-part application.

**WARNING:** Do not use this transmittal for the filing of a provisional application.

**NOTE:** If one of the following 3 items apply then complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF A PRIOR U.S. APPLICATION IS CLAIMED and a NOTIFICATION IN PARENT APPLICATION OF THE FILING OF THIS CONTINUATION APPLICATION

Divisional  
 Continuation  
 Continuation-in-part (C-I-P)

## 2. Benefit of Prior U.S. Application(s) (35 USC 119(e), 120 or 121)

**Note:** A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. Each prior application must also be:

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
- (ii) Complete as set forth in § 1.51(b); or
- (iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or
- (iv) entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the same period set forth in § 1.53(f).  
37 C.F.R. § 1.78(a)(1).

**NOTE:** If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

**WARNING:** If an application claims the benefit of the filing date of an earlier filed application under 35 USC 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 USC 120, 121 or 365(c), (35 USC 154(a)(2) does not take into account, for the determination of the patent term, any application to which priority is claimed under 35 USC 119, 365(a) or 365(b).) For a C-I-P application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20, 195, at 20,205

**WARNING:** When the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. See 37 C.F.R. § 1.78(a)(3)

The new application being transmitted claims the benefit of prior U.S. application(s) and enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

### 3. Papers Enclosed

A. Required For Filing Date Under 37 CFR 1.53(b) (Regular) or 37 CFR 1.153 (Design) Application

127 Pages of specification  
11 Pages of claims  
14 Sheets of Drawing

**WARNING:** DO NOT submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. For comments on proposed new 37 CFR 1.84. Notice of March 9, 1988 (1990 O.G. 57-62).

**NOTE:** "Identifying indicia, if provided, should include the application number or title of the invention, inventor's name, docket number, and the name and phone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm. (5/8") down from the top of the page." 37 CFR 1.84(c).

(complete the following, if applicable)

The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWINGS(S)". 37 CFR 1.84(b).

formal  
 informal

B. Other Papers Enclosed

10 Pages of declaration and power  
1 Pages of Abstract  
 Other

### 4. Additional papers enclosed

Amendment to claims

Cancel in this application claims 1-34 before calculating the filing fee.  
(at least one original independent claim must be retained for filing purposes.)

Add the claims shown on the attached amendment. (claims added have been numbered consecutively following the highest numbered original claim.)

Preliminary Amendment

Information Disclosure Statement (37 CFR 1.98)

Form PTO-1449 (PTO/SB/08A and 08/B)

Citations

Declaration of Biological Deposit

Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

Authorization of Attorney(s) to Accept and Follow Instructions from Representative  
Special Comments

Other  Associate Power of Attorney  
 Petition to Make Special

**5. Declaration or oath (including power of attorney)**

**NOTE:** A newly executed declaration is not required in a continuation or divisional application provided that the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47, then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 C.F.R. § 163(d)(1)-(3).

**Note:** A declaration filed to complete an application must be executed, identify the specification to which it is directed, identify each inventor by full name including family name and at least one given name, without abbreviation together with any other given name or initial, and the residence, post office address and country or citizenship of each inventor, and state whether the inventor is a sole or joint inventor. 37 C.F.R. § 1.63(a)(1)-(4).

**Note:** "The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.62, except as provided in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(l) is filed supplying or changing the name or names of the inventor or inventors." 37 C.F.R. § 1.41(a)(1).

Enclosed  
executed by (*check all applicable boxes*)  
 inventor.  
 legal representative of inventor(s) 37 CFR 1.42 or 1.43  
 joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached  
     This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See *item 13 below for fee*.  
 Not enclosed

**WARNING:** *Where the filing is a completion in the U.S. of an International Application but where a declaration is not available or where the completion of the U.S. application contains subject matter in addition to the International Application the application may be treated as a continuation or continuation-in-part, as the case may be, utilizing ADDED PAGE FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION CLAIMED.*

— Application is made by a person authorized under 37 CFR 1.41(c) on behalf of *all the above named inventor(s).*

*(The declaration or oath, along with the surcharge required  
by 37 CFR 1.16(e) can be filed subsequently.)*

— Showing that the filing is authorized. *(Not required unless called into question. 37 CFR 1.41(d).*

## **6. Inventorship Statement**

**NOTE:** If the named inventors are each not the inventors of all the claims an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.

**The inventorship for all the claims in this application are:**

X The same or  
Are not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted will be submitted.

## 7. Language

NOTE: An application including a signed oath or declaration may be filed in a language other than English. A verified English translation of the non-English language application and the processing fee of \$130.00 required by 37 CFR 1.17(k) is required to be filed with the application or within such time as may be set by the Office. 37 CFR 1.52(d).

NOTE: A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 CFR 1.69(b).

English

non-English

the attached translation includes a statement that the translation is accurate.  
37 CFR 1.52(d).

## 8. Assignment

An assignment of the invention to Palatin Technologies, Inc..

is attached. A separate  "COVER SHEET FOR ASSIGNMENT DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or  FORM PTO 1595 is also attached.

will follow.

NOTE: "If an assignment is submitted with a new application, send two separate letters – one for the application and one for the assignment." Notice of May 4, 1990 (1114 O.G. 77-78).

WARNING: A newly executed "CERTIFICATE UNDER 37 CFR 3.73(b)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.

## 9. Certified Copy

Certified copy(ies) of application(s)

(country)	(appln.no.)	(filed)

(country)	(appln.no.)	(filed)
from which priority is claimed. <input type="checkbox"/> is (are) attached.		

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 CFR 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application then complete item 18 on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

## 10. Fee Calculation (37 CFR 1.16)

### A. Regular application

CLAIMS AS FILED						
Number Filed		Number Extra		Rate	Basic Fee 37 CFR 1.16(a) \$690.00	
Total Claims 37 CFR 1.16(c)	28	- 20 =	8	X	\$18.00	144.00
Independent Claims 37 CFR 1.16(b)	7 - 3 =	4	X	\$78.00	312.00	
Multiple dependent claim(s), if any 37 CFR 1.16(d)			X	\$260.	0.00	

- Amendment canceling extra claims enclosed.
- Amendment deleting multiple-dependencies enclosed.
- Fee for extra claims is not being paid at this time.

**NOTE:** *If the fees for extra claims are not paid on filing they must be paid or the claims canceled by amendment prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 CFR 1.16(d).*

Filing Fee Calculation      \$ 1,146.00

B.  Design Application      (\$310.00 – 37 CFR 1.16(f))      \$ 310.00  
 C.  Plant Application      (\$480.00 – 37 CFR 1.16(g))      \$480.00

Filing Fee Calculation      \$ \_\_\_\_\_

#### 11. Small Entity Statement(s)

Verified Statement(s) that this is a filing by a small entity under 37 CFR 1.9 and 1.27 is (are) attached

**WARNING:** *"Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the continuing or reissue application. A nonprovisional application claiming benefit under 35 USC 119(e), 120, 121 or 365(c) of a prior application may rely on a verified statement filed in the prior application or if the nonprovisional application or the reissue application includes a reference to a verified statement in the prior application or includes a copy of the verified statement filed in the prior application if status as a small entity is still proper and desired." 37 CFR § 1.28(a).*

(complete the following, if applicable)

Status as a small entity was claimed in prior application U.S. Serial No. 08/660,697 filed on June 5, 1996 from which benefit is being claimed for this application under:

35 USC      119(e)

120

121

365(c),

and which status as a small entity is still proper and desired.

A copy of the Verified Statement in the prior application is included.  
 Filing Fee Calculation (50% of A, B, or C above)      \$ 573.00

**NOTE:** *Any excess of the full fee paid will be refunded if a verified statement and a refund request are filed within two months of the date of timely payment of a full fee. 37 CFR 1.28(a). The two-month period is not extendable under § 1.136. 37 CFR 1.28(a)*

#### 12. Request for International-Type Search (37 CFR 1.104(d)) (complete if applicable)

- Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

**13. Fee Payment Being Made At This Time**

Not Enclosed  
 No filing fee is to be paid at this time. (*This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently.*)  
 Enclosed  
 basic filing fee \$ 573.00

recording assignment (\$40.00; 37 CFR 1.21(h)) [see attached COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION] \$ \_\_\_\_\_

petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached (\$130.00; 37 CFR 1.47 and 1.17(i)) \$ \_\_\_\_\_

for processing an application with a specification in a non-English language (\$130.00; 37 CFR 1.52(d) and 1.17(k)) \$ \_\_\_\_\_

processing and retention fee (\$130.00; 37 CFR 1.52(d) and 1.21(l)) \$ \_\_\_\_\_

fee for international-type search report \$40.00; 37 CFR 1.21(e)) \$ \_\_\_\_\_

**NOTE:** 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(f) and this, as well as the changes to 37 CFR 1.53 and 1.78 (a)(1), indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid or the processing and retention fee of § 1.21(l) must be paid within 1 year from notification under § 53(f).

Total fees enclosed \$ 573.00

**14. Method of Payment of Fees**

Check(s) in the amount of \$ 573.00  
 Charge Account No. 13-4213 in the amount of \$ \_\_\_\_\_. A duplicate of this transmittal is attached.  
**NOTE:** Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

## **15. Authorization to Charge Additional Fees**

**WARNING:** If no fees are to be paid on filing the following items should not be completed.

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 13-4213:

37 CFR 1.16(a), (f) or (g) (filing fees)

37 CFR 1.16(b), (c) and (d) (presentation of extra claims)

**NOTE:** Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

37 CFR 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

37 CFR 1.17(a)(1)-(5) (application processing fees)

**NOTE:** "...A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a construction petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b).

**NOTE:** Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

**NOTE:** 37 CFR 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

## **16. Instructions As To Overpayment**

**Note:** "...amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payor be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

credit Account No. 13-4213  
 refund



Stephen A. Slusher,  
PEACOCK, MYERS & ADAMS, P.C.  
P. O. Box 26927  
Albuquerque, New Mexico 87125-6927  
Direct line: (505) 998-6130

Reg. No. 43,924

Tel. No. (505) 998-1500

Customer No. 005179

**Incorporation by reference of added pages**

*Check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional, provisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED*

Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

Number of pages added four (4)

Plus Added Pages For Papers Referred To In Item 4 Above

Number of pages added seven (7)

Plus added pages deleting names of inventor(s) named in prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application

Number of pages added \_\_\_\_\_

Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added \_\_\_\_\_

**Statement Where No Further Pages Added**

*(If no further pages form a part of this Transmittal then end this Transmittal with this page and check the following item)*

This transmittal ends with this page.

Practitioner's Docket No. 70025-9902-11

PATENT

ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF  
PRIOR U.S. APPLICATION(S) CLAIMED

NOTE: See 37 CFR 1.78(a).

**17. Relate Back**

**WARNING:** *If an application claims the benefit of the filing date of an earlier filed application under 35 USC 120, 121 or (365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 USC 120, 121 or 365(c), (35 USC 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 USC 119, 365(a) or (365(b).) For a C-I-P application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.*

(complete the following, if applicable)

Amend the specification by inserting, before the first line, the following sentence:

**A. 35 USC 119(e)**

NOTE "Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 CFR § 1.78(a)(4).

— "This application claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION(S) FILING DATE(S)

Serial No. \_\_\_\_\_ "

**B. 35 USC 120, 121 and 365(c)**

NOTE: "Except for a continued prosecution application filed under § 1.53(d) any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisionals or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to such each prior application identifying it by application number (consisting of the series code and serial number) or the international application number and international filing date and indicating the relationship of the applications." Cross-references to other related applications may be made when appropriate (See § 1.14(b))," 37 CFR § 1.78(a)(2).

This application is a \_\_\_\_\_ continuation; \_\_\_\_\_ continuation-in-part;  divisional of copending application(s)

serial number 08/660,697 filed on June 5, 1996.

International Application \_\_\_\_\_ filed on \_\_\_\_\_ and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application which entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application which designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application then the filing can be as a continuation-in-part or (2) it is desired to do so for other reasons, then the filing can be as a continuation.

**NOTE:** The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:  
"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 and 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 and 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as a paragraph (h) of § 1.494 and paragraph (l) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

X "The nonprovisional application designated above, namely application 08/660,697, filed June 5, 1996, claims the benefit of U.S. Applications(s) No(s).:

APPLICATION NO(S).: 08476,652 FILING DATE(S): June 7, 1995

[Where more than one reference is made, please combine all references into one sentence]

#### 18. Relate Back – 35 U.S.C. 119 Priority Claim for Prior Application

The prior U.S. application(s), including any prior International Application designating the U.S. identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

country	appn. no.	filed on
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The certified copy(ies) has (have)

\_\_\_\_ been filed on \_\_\_\_ in prior application \_\_\_, which was filed on \_\_\_\_  
\_\_\_\_ is (are) attached.

**WARNING:** The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications which have not entered the national stage may not be relied on.  
Notice of April 28, 1987 (1079 O.G. 32 to 46)

### **19. Maintenance of Copendency of Prior Application**

*NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).*

A.  Extension of time in prior application  
*(This item must be completed and the papers filed in the prior application if the period set in the prior application has run)*

A petition, fee and response extends the term in the pending prior application until \_\_\_\_\_.  
 A copy of the petition filed in prior application is attached.

B.  Conditional Petition for Extension of Time in Prior Application  
*(complete this item if previous item not applicable)*

A conditional petition for extension of time is being filed in the pending prior application.  
 A copy of the conditional petition filed in the prior application is attached.

### **20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed**

*(complete applicable item (a), (b) and/or (c) below)*

(a)  This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are  
 the same  
 less than those named in the prior application and it is requested that the following inventor(s) identified for the prior application be deleted:

*(Type name(s) of inventor(s) to be deleted)*

(b)  This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application the inventor(s) in this application are  
 the same  
 the following additional inventor(s) have been added

*(Type name(s) of inventor(s) to be added)*

(c)  The inventorship for all the claims in this application are  
 the same  
 not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made  
 is submitted  
 will be submitted

### **21. Abandonment of Prior Application (if applicable)**

Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

*NOTE: According to the Notice of May 13, 1983 (103 TMOG 6-7) the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.*

**22. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment**

**WARNING:** "The claims of a new application may be finally rejected in the first Office Action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all the claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds of art of record in the next Office Action if they had been entered in the earlier application." MPEP, § 706.07(b) 7th ed.

**NOTE:** Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

There is provided herewith a Petition to Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

**23. SMALL ENTITY (35 CFR § 1.28(a))**

Applicant has established small entity status by the filing of a verified statement in parent application Serial number 08/660,697 on June 5, 1999.

A copy of the verified Statement previously filed is included.

**WARNING:** See 37 CFR § 1.28(a).

**WARNING:** "A Small entity status must not be established when the person or persons signing the...statement can unequivocally make the required self-certification." M.P.E.P. § 509.03, 7<sup>th</sup> ed. (Emphasis added)

**24 NOTIFICATION IN PARENT APPLICATION OF THIS FILING**

A notification of the filing of this (check one of the following)

continuation

continuation-in-part

divisional

is being filed in the parent application, from which this application claims priority under 35 USC § 120.

File: 70025-9902  
[F:\MIKE\PATENT\Palatin-Rhomed\Div-II\ptotrans.doc]

Practitioner's Docket No. 70025 - 9902**PATENT**

Applicant Shubh D. Sharma       Patentee \_\_\_\_\_  
 Application No. 08/660,697       Patent No. \_\_\_\_\_  
 Filed on June 5, 1996       Issued on \_\_\_\_\_  
Title: Structurally Determined Metallo-Constructs and Applications

**STATEMENT CLAIMING SMALL ENTITY STATUS  
(37 CFR 1.9(f) and 1.27(c))—SMALL BUSINESS CONCERN**

I hereby state that I am

the owner of the small business concern identified below;  
 an official of the small business concern empowered to act on behalf of the concern identified below:

Name of Small Business Concern RHOMED INCORPORATED

Address of Small Business Concern 214 Carnegie, Center, Suite 100  
Princeton, New Jersey 08540

I hereby state that the above identified small business concern qualifies as a small business concern, as defined in 37 CFR 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office under Sections 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third-party or parties controls or has the power to control both.

I hereby state that rights under contract or law have been conveyed to, and remain with, the small business concern identified above, with regard to the invention described in

the specification filed herewith, with title as listed above.  
 the application identified above.  
 the patent identified above.

If the rights held by the above-identified small business concern are not exclusive, each individual, concern or organization having rights in the invention is listed below and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(e), if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

**NOTE: Separate statements are required from each named person, concern or organization having rights to the invention as to their status as small entities. (37 CFR 1.27)**

Each such person, concern or organization having any rights in the invention is listed below:

No such person, concern, or organization exists.  
 Each such person, concern or organization is listed below.

Name \_\_\_\_\_

Address \_\_\_\_\_

INDIVIDUAL

SMALL BUSINESS CONCERN

NONPROFIT ORGANIZATION

Name \_\_\_\_\_

Address \_\_\_\_\_

INDIVIDUAL

SMALL BUSINESS CONCERN

NONPROFIT ORGANIZATION

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small business entity is no longer appropriate. (37 CFR 1.28(b))

(check the following item, if desired)

NOTE: The following verification statement need not be made in accordance with the rules published on Oct. 10, 1997, 62 Fed. Reg. 52,131, effective Dec. 1, 1997.

NOTE: "The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15)." 37 C.F.R. § 1.4(d)(2).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Name of Person Signing Carl Spana, Ph.D.

Title of Person if Other Than Owner Executive Vice President

Address of Person Signing 214 Carnegie Center, Suite 100

Princeton, New Jersey 08540

SIGNATURE Carl S. Date July 14, 1999